

## **REMARKS / ARGUMENTS**

### **I. General Remarks**

Applicants respectfully request that the above amendments be entered and further request reconsideration of the application in view of the amendments and the remarks contained herein.

### **II. Disposition of the Claims**

At the time of the office action, claims 1-6, 8-13, 15-18, 20-23, and 25-28 were pending in this application. Claims 1-6, 8-13, 15-18, 20-23, and 25-28 stand rejected.

Claims 1, 8, 15, and 20 are amended herein. Applicants respectfully submit that these amendments add no new matter to the application and are supported by the specification as filed. All the above amendments are made in a good faith effort to advance the prosecution on the merits of this case.

### **III. Remarks Regarding Rejection of Claims Under 35 U.S.C. § 102(b)**

Claims 1, 6, 8, 13, 25, and 26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,024,171 issued to Montgomery *et al.* (hereinafter "*Montgomery*"). Applicants respectfully disagree, because *Montgomery* does not teach or suggest every limitation of claims 1, 6, 8, 13, 25, and 26 as required to anticipate the claims under 35 U.S.C. § 102(b). MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (2004). In particular, *Montgomery* fails to teach the step of "fracturing the coal seam using a hydrajetting tool at a pressure less than a fracture pressure of the subterranean formation ...wherein the fracturing minimizes the creation of near-well-bore stresses," as recited in amended independent claims 1 and 8 (emphasis added).

Near-well-bore stresses occur when a naturally-fractured coal seam is perforated and further fractured by hydraulic means. These stresses can be particularly problematic in vertical wells because formation stresses vary with depth. (*See Present Application* at [0007], emphasis added.) The perforations created by the hydraulic fracturing may create multiple and random entry points for the fracture fluid to flow into the formation. *Id.* This random flowpath, coupled with an already tortuous network of pathways within the coal seam formation, typically results in a complex fracture, which is typically not aligned with the plane of maximum stress and lacks a single, dominate fracture. This may create an inefficient and often sometimes

ineffectual pathway for the gas to reach the well bore is created. (*See Present Application* at [0007].)

Rather than disclosing minimizing the creation of near-well-bore stresses, *Montgomery* provides that “[i]n a further embodiment shown in FIG. 8, the wellbore 12 has been cased through a coal formation, perforated, and fractured. The wellbore 12 as initially completed was perforated at perforations 42 and fractured to create a fracture zone 44 in the coal formation 18.” *Montgomery*, col 5, ll. 60-64, (emphasis added). Thus, the methods of *Montgomery* which involve perforating and fracturing a coal seam may cause the formation of near-well-bore stresses, which the methods of the Present Application attempt to minimize. Accordingly, *Montgomery* does not disclose each and every limitation of independent claims 1 and 8.

Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. § 102(b) rejection as to independent claims 1 and 8 and correspondingly as to dependent claims 6 and 13. Applicants further request withdrawal of the 35 U.S.C. § 102(b) rejections as to independent claims 20, and its dependents, claims 25 and 26, for an analogous reason.

#### **IV. Remarks Regarding Rejection of Claims Under 35 U.S.C. § 103(a)**

##### **A. *Montgomery* in View of *Surjaatmadja* Does Not Teach Each and Every Limitation of Claims 2, 3, 9, and 10**

Claims 2, 3, 9, and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Montgomery* in view of U.S. Patent No. 5,765,642 issued to *Surjaatmadja*. (hereinafter “*Surjaatmadja*”). Applicants respectfully disagree on the basis of the amended claims.

To form a basis for a § 103(a) rejection, the suggested combination of prior art references must teach or suggest each and every limitation in the claim. MPEP § 2142. As discussed in Section III above, *Montgomery* does not teach or suggest “fracturing the coal seam using a hydrajetting tool at a pressure less than a fracture pressure of the subterranean formation ...wherein the fracturing minimizes the creation of near-well-bore stresses” as recited in amended independent claims 1 and 8 (emphasis added). *Surjaatmadja* also fails to teach or suggest this recited limitation. Thus, Applicants respectfully assert that the combination of *Montgomery* and *Surjaatmadja* fails to form a valid basis for a prima facie case of obviousness as to amended independent claims 1, 8 and correspondingly, as to dependents claims 2, 3, 9, and 10. Accordingly, Applicants respectfully request the withdrawal of the 35 U.S.C. § 103(a)

rejection as to independent claims 1 and 8 and correspondingly, as to their dependent claims 2, 3, 9, and 10.

**B. *Montgomery* in View of *Zupanick* Does Not Teach Each and Every Limitation of Claims 4, 5, 11, And 12**

Claims 4, 5, 11, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Montgomery* in view of U.S. Patent No. 6,280,000 issued to Zupanick (hereinafter “*Zupanick*”). Applicants respectfully disagree.

To form a basis for a § 103(a) rejection, the suggested combination of prior art references must teach or suggest each and every limitation in the claim. MPEP § 2142. As discussed in Section III above, *Montgomery* does not teach or suggest “fracturing the coal seam using a hydrajetting tool at a pressure less than a fracture pressure of the subterranean formation ...wherein the fracturing minimizes the creation of near-well-bore stresses” as recited in amended claims 1 and 8. Nor does *Zupanick* teach or suggest this limitation.

Therefore, the combination of *Montgomery* and *Zupanick* fail to form a valid basis for a prima facie case of obviousness as to amended independent claims 1 and 8 and correspondingly, as to dependent claims 4, 5, 11, and 12. Accordingly, Applicants respectfully request the withdrawal of these rejections.

**C. *Montgomery* in View of *Surjaatmadja* in View of *Zupanick* Does Not Teach Each and Every Limitation of Claims 15-18, 20-23, 27, and 28.**

Claims 15-18, 20-23, 27, and 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Montgomery* in view of *Surjaatmadja* in view of *Zupanick*. Applicants respectfully disagree on the basis of the amended claims.

A prima facie case of obviousness requires a showing that all claim limitations be taught or suggested by the prior art. MPEP § 2143.03. Applicants respectfully submit that a prima facie case of obviousness has not been established by the cited references, because the cited references fail to teach all of the limitations of amended independent claims 15 and 20.

In particular, as explained above in Section IV.A, neither *Montgomery* nor *Surjaatmadja* teaches “fracturing the coal seam using a hydrajetting tool at a pressure less than a fracture pressure of the subterranean formation ...wherein the creation of near-well-bore stresses is minimized,” as recited in amended independent claims 15 and 20. Moreover, the addition of *Zupanick* fails to supply the limitations missing from *Montgomery* and *Surjaatmadja*. As such, a prima facie case has not been established by the combination of *Montgomery*, *Surjaatmadja*, and

*Zupanick*, because these cited references fail to teach each and every limitation of Applicants' independent claims 15 and 20. Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection as to independent claims 15 and 20 and correspondingly, as to dependent claims 16-18 and 21-23, 27 and 28.

**V. No Waiver**

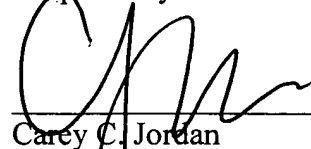
All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the cited references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements, such as, for example, any statements relating to what would be obvious to a person of ordinary skill in the art. The example distinctions discussed by Applicants are sufficient to overcome the anticipation and obviousness rejections.

**SUMMARY**

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments, or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants believe that no additional fees are due in association with the filing of this Response. However, should the Commissioner deem that any fees are due, the Commissioner is authorized to debit the Deposit Account of Baker Botts L.L.P., No. 02-0383, for any underpayment of fees that may be due in association with this filing.

Respectfully submitted,



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